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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,943	03/13/2001	David F. Broadbent	437312000420	1916
7590 George D Dickos ESQ Kirkpatrick & Lockhart LLP Henry W Oliver Building 535 Smithfield Street Pittsburgh, PA 15222-2312		07/06/2007	EXAMINER COLBERT, ELLA	
			ART UNIT 3694	PAPER NUMBER
			MAIL DATE 07/06/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/804,943	Applicant(s) BROADBENT ET AL.	
	Examiner Ella Colbert	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/17/04, 8/19/03, 4/16/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-18 are pending in this communication filed 03/29/07 entered as Response to Non-Final Action (Miscellaneous Communication).
2. The IDS's filed 06/17/04, 08/19/03, and 04/16/01 have been reviewed, entered, and submitted with this communication.
3. The Drawings filed 12/12/06 have been considered and entered. The drawings overcome the drawing objections and the drawing objections are hereby withdrawn.
4. The objection to the abstract has been overcome by the amendment to the abstract and is hereby withdrawn.
5. The 35 USC 112, second paragraph rejections for claims 1 and 7 are hereby withdrawn in view of Applicant's convincing arguments.

Specification

6. The Specification is objected to because Page 1 recites "serial no. ----- filed February 13, 2001, titled "Method and Apparatus for an ...".
"serial no. 09/804,942 filed March 13, 2001, titled "Method and Apparatus for an ...".
The computer system states March 13, 2001 as the file date. Which month is correct?
Is it February or March?
Page 15 contains the acronyms "XML"; "HTTPS"; "POST"; and "API". Acronyms, for example should be written as follows: hypertext transfer protocol system (HTTPS).
Correction is required. See MPEP § 608.01(b).

Claim Objections

7. Claim 1 is objected to because of the following informalities: Claim 1 is objected to for being in the improper method claim format. Claim 1 to be in the proper method claim format should begin each claim limitation step an "ing" verb. The claim limitations should begin with "receiving from the automatic compliance engine a ...; generating from the automatic compliance engine a plurality ..., ...; and distributing from the automatic compliance engine one or more of the task ...". Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1, 7, 12, and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear from the drawings and from reading the Specification where the claim limitations to the independent claims are discussed and shown in the drawing figure(s).

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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11. Claims 1, 2, 4-7, 9-12, 14, 15, 17, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, recites a plurality of tasks, ... comprising actions required to process the mortgage loan ...;". It is unclear what tasks and actions are required to process the mortgage loan. Claims 7, 11, 12, and 15 have a similar problem. Claims 2 and 12 contain a "whereby" clause and claims 4-6, 9-10, 13, 14, 17 and 18 contain a "wherein" clause. See MPEP 211.04 regarding "wherein" and "whereby" clauses. The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "whereby" clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited." *Id.*<

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-4, 7, 8, 10-12, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,611,052) Dykstra et al, hereafter Dykstra in view of (US 6,709,095) Anderson et al, hereafter Anderson.

Claim 1. Dykstra discloses, A computer implemented method for generation of a set of required procedures for processing a mortgage loan using an Internet based system having a client loan origination system electronically coupled to an automatic compliance engine, the method comprising the acts of:
the automatic compliance engine receiving a request to process a mortgage loan from the client loan origination system (col. 4, lines 12-40 and Fig. 2A);
the automatic compliance engine generating a plurality of tasks, the tasks comprising actions required to process the mortgage loan, including tasks required by applicable federal or state law (Fig.s 2A –2F); and the automatic compliance engine distributing one or more of the tasks to the client loan origination system (col. 3, line 33-col. 14, line 11 and Fig's 1-2A. Dykstra does not expressly disclose the plurality of tasks including tasks required by federal or state law. However, this is disclosed by Anderson as processing the mortgage loan application, and said application designed to be compiled with mortgage lending regulations (col. 10, lines 65-67 and Fig. 25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the mortgage processing method of Dykstra to include the feature of the requiring mortgage application process to be complied with the mortgage lending regulations to prevent illegal loan transactions.

Claim 2. Dykstra discloses, The computer implemented method for automated

processing a mortgage loan of claim 1 comprising the additional act of the automatic compliance engine monitoring completion of the plurality of tasks whereby a report of completion of all required tasks can be generated (Fig. 2A- disclosed by Dykstra as generating a report when the loan process is completed).

Claim 3. Dykstra discloses, The computer implemented method for automated processing of a mortgage loan of claim 1 comprising the additional act of the automatic compliance engine authenticating a person submitting the request to process a mortgage loan (Fig. 2A –2B).

Claim 4. Dykstra discloses, The computer implemented method for automated processing of a mortgage loan of claim 1 wherein the plurality of tasks required to process the mortgage loan are based upon mortgage loan related laws and regulations comprising Federal, State, local and professional regulations and requirements and implementing instructions relating to mortgage loan processing is disclosed by Dykstra and modified by Anderson as processing a mortgage loan application, and said application is designed to be complied with mortgage lending regulations (See above claim 1).

Claim 7. Dykstra discloses, An apparatus for automated processing of a mortgage loan comprising: an automatic compliance engine having logic mechanisms programmed to generate a plurality of tasks, the tasks comprising actions required to process the mortgage loan, including tasks required by applicable federal or state law (col. 4, lines 18-46); the automatic compliance engine coupled electronically to a client loan application; the automatic compliance engine having communications devices for

receiving a request to process a mortgage loan from the client loan application system; and the automatic compliance engine having additional logic mechanisms programmed to electronically distribute one or more of the tasks to the client loan application system (col. 3, line 35 –col. 5, 64 and col. 6, line 10-col. 7, line 48).

Claim 8. Dykstra discloses, The apparatus of claim 7 further comprising electronic logic devices in the compliance engine programmed to monitor completion of the plurality of tasks and to generate a report of completion of all required tasks (Fig. 2A).

Claim 10. this dependent claim is rejected for the similar rationale as above for claim 1.

Claim 11, this independent claim is rejected for the similar rationale as above for claim 1.

Claim 12, this independent claim is rejected for the similar rationale as above for claim 1. Also, it is well known in the art of networks that networks have nodes or ports for connection purposes.

Claim 14. this dependent claim is rejected for the similar rationale as given above for claims 1 and 4.

Claim 15. this independent claim is rejected for the similar rationale as given above for claim 1.

Claim 16. this dependent claim is rejected for the similar rationale as given above for claims 1-4.

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14. Claims 5, 6, 9, 13, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,611,052) Dykstra et al, hereafter Dykstra in view of (US 6,709,095) Anderson et al, hereafter Anderson '095 as applied to claims 1-4 above, and further in view of US 2001/0018739) Anderson et al, here after Anderson '739.

Claim 5. Dykstra and Anderson '095 failed to disclose, The computer implemented method for automated processing of a mortgage loan of claim 1 wherein the client loan origination system communicates with the automatic compliance engine using an XML format according to an application programming interface (API) controlled by the automatic compliance engine. Anderson '095 discloses, The computer implemented method for automated processing of a mortgage loan of claim 1 wherein the client loan origination system communicates with the automatic compliance engine using an XML format according to an application programming interface (API) controlled by the automatic compliance engine (page 6, col. 1 [0059]-compliance; page 21 [0254] and [0255], page 12, col. 1 [0163 and col. 2 [0166])). The application programming interface (API) for Anderson's check system can be used for mortgage loan origination.

Claim 6. Dykstra and Anderson '095 failed to disclose, The computer implemented method for automated processing of a mortgage loan of claim 1 wherein the client loan origination system communicates with the automatic compliance engine using a web page developed for use with the automatic compliance engine. Anderson '095 discloses, The computer implemented method for automated processing of a mortgage loan of claim 1 wherein the client loan origination system

communicates with the automatic compliance engine using a web page developed for use with the automatic compliance engine ([0145]).

Claim 9. Dykstra discloses, The apparatus of claim 7 wherein the compliance engine communicates with the client loan application system using an XML format according to an API controlled by the compliance engine (col. 4, line 41 –col. 5, line 12, and Fig.'s 1-2A).

Claim 13. Dykstra and Anderson '095 failed to disclose, The network node of claim 12 wherein the mortgage loan processing server node provides a third mechanism to electronically communicate with the user node using an XML format for an API controlled by the mortgage loan processing server node. Anderson '739 discloses, The network node of claim 12 wherein the mortgage loan processing server node provides a third mechanism to electronically communicate with the user node using an XML format for an API controlled by the mortgage loan processing server node (page 6, col. 1 [0059] –compliance, page 12, col. 1 [0163] and col. 2 [0166], and page 21 [0254] and [0255]). The application programming interface (API) for Anderson's check system can be used for mortgage loan origination.

Claim 18. Dykstra and Anderson '095 failed to disclose, The computer program product of claim 15 wherein the communications with the client loan application comprises messages containing data in XML format. Anderson '739 discloses, The computer program product of claim 15 wherein the communications with the client loan application comprises messages containing data in XML format (page 5, col. 1 [0050]-col. 2 [0053]). XML is a general purpose markup language because it allows

users to define their own tags and facilitates the sharing of data across different information systems, particularly via the Internet.

Inquiries

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Wednesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

June 21, 2007


ELLA COLBERT
PRIMARY EXAMINER